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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92053773
Party	Plaintiff Jeffrey Kaplan
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Registrations No. 322,305  
For the Mark “PUSS’ N BOOTS”

Jeffrey Kaplan

Cancellation No: 92053773

Petitioner,

v.

Del Monte Corporation

Respondent

**PETITIONER’S MEMORANDUM IN SUPPORT OF MOTION TO STRIKE  
RESPONDENT’S FOUR AFFIRMATIVE DEFENSES**

Petitioner, Jeffrey Kaplan, hereby moves the Trademark Trial and Appeal Board to strike certain defenses in the Answer and Affirmative Defenses to Petition for Cancellation (the “Answer”) filed by Del Monte Corporation, (“Respondent”) herein,

**I. MOTION TO STRIKE AFFIRMATIVE DEFENSES**

1. Federal Rule 12(f) provides the Board with discretion to strike from a pleading any insufficient defense that is redundant, immaterial, or impertinent. An affirmative defense is insufficient as a matter of law if it fails to meet the general pleading standards of Federal Rule 8, which requires a short and plain statement as to each defense. (Voter Verified Inc. v. Election Sys. & Software, 2010 U.S. Dist. LEXIS 63679, at \*3-4 (M.D. Fla. June 4th, 2010).

The Supreme Court recently clarified the Federal Rule 8 standard in two different opinions. (Bell Atlantic Corp v. Twombly, 550 U.S. 554 (2007); Ashcroft v. Iqbal, 129 S. Ct. 1937 (2009).

In these opinions, the Supreme Court clarified that Federal Rule 8 required pleading to offer more than mere ‘labels and conclusions’ or ‘a formulaic recitation of the elements of a cause of action.’ (Iqbal, 129 S. Ct. at 1949 (quoting Twombly, 550 U.S. at 555).

In other words, "threadbare recitals ... supported by mere conclusory statements, will not suffice. (Iqbal, 129 S. Ct. at 1949) Therefore, "factual allegations must be enough to raise a right to relief above the speculative level." (Twombly, 550 U.S. at 555) Numerous district courts have applied both the Twombly and Iqbal standards to require a heightened pleading standard for affirmative defenses. (See *Palmer v. Oakland Farms, Inc.*, 2010 U.S. Dist. LEXIS 63265, at \*13 (W.D. Va. June 24, 2010); *Barnes v. AT&T Pension Benefit Plan*, 2010 U.S. Dist. LEXIS 62515, at \*10 (N.D. Cal. June 21, 2010). A majority of district courts in Florida have likewise applied this heightened pleading standard to affirmative defenses. (*Torres v. TPUSA Inc.*, 2009 U.S. Dist. LEXIS 22033, at \*2-3 (M.D. Fla. Mar. 19, 2009); *Holtzman v. B/E Aerospace Inc.*, 2008 U.S. Dist. LEXIS 42630, at \*6 (S.D. Fla. May 28, 2008) ("While Defendants need not provide detailed factual allegations, they must provide more than bare-bones conclusions") ("Plaintiff should not be left to discover the bare minimum facts constituting a defense until discovery"); *Home Mgmt. Solutions, Inc. v. Prescient Inc.*, 2007 U.S. Dist. LEXIS 61608, at \*9-10 (S.D. Fla. Aug. 21, 2007) ("Without some factual allegation in the affirmative defense, it is hard to see how a defendant could satisfy the requirement of providing not only 'fair notice' of the nature of the defense, but also 'grounds' on which the defense rests.") (quoting *Twombly*, 550 U.S. at 556 n3). Each improper boilerplate affirmative defense asserted by Respondent is taken in turn:

1. First Affirmative Defense: Failing to Allege Facts to State a Claim

Respondent's first affirmative defense must be stricken because it offers a threadbare and conclusory recital of the language of Federal Rule 12(b)(6) as to how Plaintiff somehow "fails to allege facts sufficient to state a claim on which relief can be granted.

An alleged failure to state a claim on which relief can be granted is not an affirmative defense. (See *Energetic Sys. v. Kayser*, 1986 U.S. Dist. LEXIS 22681 (N.D. Ill. 1986).

Moreover, the Courts has been clear that a threadbare and conclusory defense that a plaintiff failed to state a claim is insufficient under the Twombly and Iqbal pleading standards. (See Torres, 2009 U.S. Dist. LEXIS 22033, at \*2-3) Other districts in Florida have similarly held that a boilerplate affirmative defense which merely quotes Rule 12(b)(6) should be stricken. (See Castillo v. Roche Labs, Inc., 2010 U.S. Dist. LEXIS 87681, at \*10-11 (S.D. Fla. Aug. 2, 2010) (citing Merrill Lynch Business Financial Services Inc. v. Performance Machine System U.S.A., Inc., 2005 U.S. Dist. LEXIS 7309, at \*37-38 (S.D. Fla. Mar 4, 2005)).

If Respondent had truly believed that Petitioner's Petition to Cancel failed to satisfy the dictates of Federal Rule 12(b)(6) they had their opportunity to respond to the Petition to Cancel by filing a motion to dismiss. Alternatively, Respondent could have filed a motion seeking a more definitive statement under Rule 12. However, Respondent did neither and instead opted to file an answer and assert various boilerplate affirmative defenses. Accordingly, Respondent has waived the right to argue that Petitioner's abandonment claims fail to allege facts sufficient to state a claim – and thus the first affirmative defense should be stricken.

## **2. Respondent's Second Affirmative Defense Claims that Petitioner Lacks Standing**

On March 17<sup>th</sup> 2011 Petitioner filed an intent- to- use application with the U.S.P.T.O. for the mark PUSS N' BOOTS – Serial No. 85269420 for Cat Food which is identical to Respondent's U.S. Trademark Registration No: 322,305. The Petitioner believes it is or will be damaged by Registrant's U.S. Trademark Registration No: 322,305 for the mark PUSS N' BOOTS. The standard for "lack of standing" is clear and as long as Petitioner "**believes**" it is or will be damaged by Registrant's trademark he clearly has standing.

Respondent cannot show that Petitioner lacks standing. Therefore, Petitioner clearly has standing and Respondent's Second Affirmative Defense should be stricken.

3. **Respondent's** Third Affirmative Defense Claims Petitioner Committed Fraud on the USPTO and Petitioner Has Lack of Bona Fide Intent to Use the Mark.

Respondent's Third Affirmative Defense regarding other unsubstantiated and unrelated prior TTAB matters between the Petitioner and others, has no relevance in this proceeding. Petitioner has filed a bona-fide intent-to use application with the U.S.P.T.O. for the mark PUSS 'N BOOTS – Serial No. 85269420 for cat food. Petitioner owns a successful active for profit-corporation named Retrobrands U.S.A. Inc. ([www.retrobrands.net](http://www.retrobrands.net)) whose primary goal and business model is to re-launch abandoned brands.

With regard to Respondent's third affirmative defense concerning Petitioner's lack of bona fide intent to use its pleaded mark, the Board should find it appropriate to strike such defense to the extent that such an allegation constitutes an attempted collateral attack on the validity of Petitioner's pleaded mark and the only type of counterclaim that may be entertained by the Board should be a counterclaim for cancellation of a registration owned by an adverse party (not an asserted application) (See "Pyttronic Industries Inc. v. Terk Technologies Corp., 16 USPQ2d 2055 (TTAB 1990); and International Telephone and Telegraph Corp. v. International Mobile Machines Corp., 218 USPQ 1024 (TTAB 1983). In as much as Respondent's proposed attempted counterclaim does not seek cancellation of any registration owned by Petitioner it is legally deficient.

In regards to Respondent's fraud defense, Respondent merely states that "Petitioner has committed fraud on the USPTO". Any affirmative defense accusing the Petitioner of inequitable conduct before the USPTO based upon fraud must be pled with particularity and is subject to the heightened Pleading standard of Federal Rule 9(b). (See *Magarl, LLC v. Crane Co.*, 2005 U.S. Dist. LEXIS 24283, at \*12 (S.D. Ind. 2004).

See also *Ferguson Beauregard/Logic Controls v. Mega Sys., LLC*, 350 F.3d 1327, 1344 (Fed. Cir. 2003) (“inequitable conduct, while a broader concept than fraud, must be pled with particularity”). Thus, a mere boilerplate and conclusory affirmative defense which states that a trademark cannot be enforced due to fraud on the USPTO should thus be stricken for failure to plead with sufficient particularity. (See *Wellman, Inc. v. Teijin, Ltd.*, 2006 U.S. Dist. LEXIS 54311, at \*3-5 (W.D. Wis. Aug. 4, 2006) (striking affirmative defense that patent was unenforceable due to fraud before USPTO). Thus, Respondent’s single sentence vague allegation of fraud before the USPTO regarding Petitioner’s unrelated prior proceedings should be stricken. (See generally, *Netflix, Inc. v. Blockbuster Inc.*, 2006 U.S. Dist. LEXIS 63154, at \* 22-23 (N.D. Cal. Aug. 22, 2006).

Lastly, fraud on the U.S. Trademark office is made in the procedural context of cancellation of a Registration or opposition of an application. (*Toro Co. v. Grass Masters Inc.* 66 U.S.P.Q. 2d 1032, 2003 WL 1786056)(TTAB 2003) (false statement in 8 and 15 affidavit of continued use of mark was abandoned precludes Opposer from relying upon that registration). Fraud cannot be asserted against applications that are not being opposed or cancelled. (*Paramount Pictures Corp. v. Dorney Park Coaster Co.*, 698 F. Supp. 1274, 9 U.S.P.Q.2d 1161) (E.D. Pa. 1988) (alleged fraud in a pending application should not provide a defense).

Accordingly Respondent’s Third Affirmative Defense should be stricken.

#### 4. Fourth Affirmative Defenses: Unclean Hands

Respondent’s fourth affirmative defense asserts an equitable defense sounding in unclean hands. This affirmative defense as pled is wholly insufficient as a matter of law. (*O’Gara ex rel. Portnick v. Countrywide Home Loans, Inc.*, 2010 U.S. Dist. LEXIS 77130, at \*3-4 (D. Del. July 30, 2010) (striking barebones affirmative defenses sounding in unclean hands).

(See also *Strom v. Strom Closures, Inc.*, 2008 U.S. Dist. LEXIS 12375, at \*18-19 (N.D. Ill. Feb. 20, 2008) (“affirmative defenses 2 and 3 contain nothing more than conclusory references to the equitable defenses of unclean hands and laches. Therefore, we grant the motion to strike affirmative defenses 2 and 3”). Accordingly, this equitable affirmative defense as pled by Respondent should be stricken, as they fail to provide any notice of the grounds upon which they rest. (See *Glover v. Mary Jane M. Elliott, P.C.*, 2007 U.S. Dist. LEXIS 73605, at \*3-4 (W.D. Mich. Oct. 2, 2010) (“broad affirmative defenses such as waiver, estoppel, or unclean hands may be stricken where these defenses are alleged in conclusory fashion without any factual basis, thereby depriving plaintiff a fair notice of the grounds upon which the defense rests”).

In addition case law shows that equitable defenses such as unclean hands are not available in light of the overriding public interest in removing abandoned registrations from the register. (See *Treadwell's Drifters Inc. v. Marshak*, 18 U.S.P.Q. 2d 1318, 1320) (TTAB 1990) (“we can hold, as a matter of law, that respondent’s asserted equitable defenses are not available against the claims of fraud and abandonment”); *Harjo et al. v. Pro Football, Inc.*, 30 U.S.P.Q. 2d 1828, 1831 (“The Board has held that the equitable defense of laches and estoppels are not available against claims of fraud and abandonment because there exists a broader interest- a “public policy” interest- in addition to a private interest in removing from the register those registrations ...that have been abandoned.”) In the Petition, Petitioner clearly alleges that Respondent’s registration has been abandoned and should be cancelled. Because of the clear precedent in the case law, Respondent’s Fourth Affirmative Defense should be stricken. It is not possible that Respondent could be harmed in an equitable sense if its trademark is abandoned.

In sum, Petitioner wishes to minimize the time and cost of litigation by striking defenses that are clearly not germane to the Petition. Ultimately, Petitioner wishes for the Board's focus to be focused squarely on the issue of whether Registrant's trademarks rights have been abandoned. Petitioner prays that Respondent's Four Affirmative Defenses are stricken.

Respectfully submitted,

/Jeffrey Kaplan/  
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4/29/11

CERTIFICATE OF MAILING

It is hereby certified that this document is being deposited First Class Postage Prepaid with the U.S. Postal Service addressed to Orrick Herrington & Sutcliffe LLP; Att: Chelsea E.L. Bush, Esq. – 405 Howard Street San Francisco, CA 94105

/Jeffrey Kaplan/  
4/29/11